

Docket No.: NAI1P004_00.006.01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re the application of

Melchione

Application No. 09/585,811

Filed: May 31, 2000

For: SYSTEM, METHOD AND
COMPUTER PROGRAM PRODUCT FOR
PROCESS-BASED SELECTION OF VIRUS)
DETECTION ACTIONS

Group Art Unit: 2785

Examiner: Unassigned

Docket No. NAI1P004_00.006.01

Date: March 26, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231 on March 26, 2003.

Signed:

Erica L. Farlow

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Technology Center 2100

Commissioner for Patents
Washington D.C. 20231

REQUEST FOR RECONSIDERATION OF
PETITION TO MAKE SPECIAL
37 C.F.R. 1.102 and MPEP § 708.02(XI)

Sir:

This request for reconsideration is filed in response to the Decision on Petition To Make Special mailed March 12, 2003. This request incorporates by reference the content of the original petition mailed February 7, 2003.

The Special Program Examiner states that:

"Petitioner's submission fails to meet the criteria set out with respect to countering terrorism in M.P.E.P 708.02(XI). The specification and claim[s] as originally filed provide no indication of an intention to counter terrorism by contributing to the identification and detection of [a] Virus."

It appears that the operative words in the Examiner's statements above is that "the specification and claim[s] as originally filed provide no indication of an intention to counter terrorism by contributing to the identification and detection of [a] Virus" (emphasis added).

Applicant respectfully disagrees. 18 U.S.C. 2332b (as amended by the 2001 US Patriot Act) defines terrorism as any act carried out by a person who "knowingly causes the transmission of a program, information, code, or command, and as a result of such conduct, intentionally causes damage without authorization, to a protected computer." Computer virus proliferation clearly meets the foregoing definition. Moreover, the present claimed invention contributes to countering virus proliferation by identifying and detecting the fruits (i.e. the virus, etc.) of such criminal behavior for the purpose of dampening its effect, thus, "countering" the same.

In the above excerpt, it appears that the Examiner is suggesting that, due to the absence of the explicit word "terrorism" in applicant's specification and claims, applicant is not entitled to acceleration under MPEP § 708.02(XI). Applicant asserts that such rationale would constitute "form over substance," and improperly work contrary to the intent of the MPEP rule. Statutes clearly define virus proliferation as terrorism, and the present invention sets forth an intention to prevent viruses from being downloaded by identifying and detecting the same. The criteria under MPEP § 708.02(XI) is clearly met.

The Examiner continues by stating:

"The declaration supporting the petition describes steps to identify and detect the file that contains [a] Virus. However, the claimed invention fails to indicate countering terrorism. Moreover, "identifying" and "detecting" do not equate to "countering." Further steps would be required to actually offset or nullify terrorism, yet no suggestion of "countering" is found in the disclosure. As a result, no advancement in the technology of countering terrorism has been persuasively shown."

Applicant again respectfully disagrees. Applicant emphasizes that the claimed "identifying" and "detecting" enable the "countering" of the legislatively-defined acts of cyber-terrorism. Moreover, contrary to the Examiner's statement above, there is indeed an explicit suggestion of "countering" in applicant's originally filed disclosure. See the excerpt from pages 13 and 14 of the originally filed specification below.

"Thus, the foregoing technique is particularly beneficial since it allows the system administrator to ensure that users are prevented from downloading infected files from the Internet whether they are using Internet Explorer®, Netscape® or some other application that is not commonly known."

Applicant has further amended the claims of the present application to emphasize such "countering." See the attached copy of Preliminary Amendment C which was filed coincidentally herewith. Applicant thus clearly teaches and claims acts that "counter" legislatively-defined acts of cyber-terrorism.

Below is an excerpt from MPEP § 708.02(XI):

"In view of the importance of developing technologies for countering terrorism and the desirability of prompt disclosure of advances made in these fields, the U.S. Patent and Trademark Office will accord "special" status to patent applications relating to counter-terrorism inventions....

Applicants who desire that an application relating to inventions for countering terrorism be made special should file a petition with the

petition fee under 37 CFR 1.17(h) requesting the U.S. Patent and Trademark Office to make the application special. The petition for special status should be accompanied by a statement explaining how the invention contributes to countering terrorism."

Simply nowhere is there any mention in the above MPEP section or in the legislative intent any requirement for the word "terrorism" to be used in applicant's disclosure to qualify for accelerated prosecution under the above MPEP section. Moreover, applicant has clearly shown the manner in which legislatively-defined acts of "terrorism" are "countered." Again, to deny applicant's petition due to the lack of the explicit word "terrorism," when terrorist actions (as defined by statute) and "countering" techniques are clearly described therein, would constitute "form over substance" rationale, and would improperly frustrate the intent of the relevant MPEP section.

It is well known and clearly evident from the United States legislation, media, etc. that cyber-terrorism is a significant threat to the national security of the United States. The present invention clearly counters such terrorism by effectively contributing to the prevention of virus proliferation which would detrimentally affect computers and networks in this country. To deprive the public quickened access to such technology in view of formalities would be in direct conflict with the purpose of the legislation that prompted the above MPEP section in 1996. In the words of Bruce A. Lehman, former Assistant Secretary of Commerce and Commissioner of Patents and Trademarks:

"By allowing "special" status for inventions that prevent or deter terrorism, those tools will be in the hands of those who need them more quickly."

<http://www.uspto.gov/web/offices/com/speeches/96-11.txt>

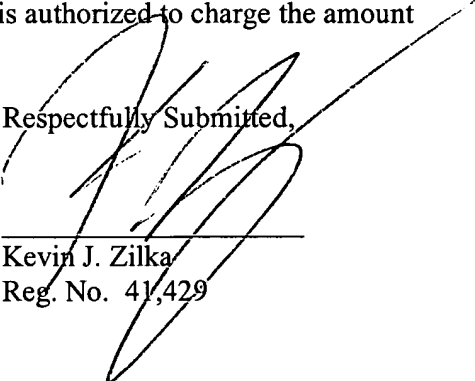
Applicant again petitions for a grant of the above petition to make special. If the Examiner continues to be unpersuaded by the above remarks, he is respectfully requested to contact the undersigned to discuss this matter.

If it is determined that any additional fee is due, the Office is authorized to charge the amount to deposit account 50-1351 (Order No. NAI1P004).

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Respectfully Submitted,



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